

REMARKS / DISCUSSION OF ISSUES

Claims 1, 3-9, 11-14, and 16-23 are pending in the application. Claims 2, 10, and 15 are canceled herein, and claims 21-23 are added.

Claims are amended for non-statutory reasons. The claims are not narrowed in intended scope, and no new matter is added.

The Office action rejects claims 1-20 under 35 U.S.C. 101. The applicants respectfully traverse this rejection.

The Office action asserts that the claims define nothing more than a mathematical algorithm that, by itself, is a Judicial Exception; and suggests "clarifying the claimed practical application so as to exclude recitation of every 'substantial practical application' of the claimed law of nature".

The applicants note that independent claims 1 and 9 define specific methods for identifying and characterizing a plurality of items, independent claims 14 and 20 define systems for identifying mean items for a plurality of items, and independent claim 19 defines an article of manufacture for identifying mean items for a plurality of items. These claims do not recite "every substantial application of a law of nature", as asserted in the Office action. These claims include specific limitations for identifying and characterizing items, and thus cannot be said to cover every substantial application for identifying and characterizing items. As such, the applicants respectfully request the Examiner's reconsideration of the rejection of claims 1, 3-9, 11-14, and 16-20 under 35 U.S.C. 101.

The Office action also asserts that claim 19 is directed to a disembodied computer program. The applicants respectfully disagree with this assertion. Claim 19 clearly claims an article of manufacture that includes a computer program that is embodied on a computer readable medium, and thus cannot be said to be directed to a disembodied computer program.

The Office action rejects claims 1, 3-7, 9, 11-12, 14, 16-17, and 19-20 under 35 U.S.C. 102(b) over Chislenko et al. (USP 6,041,311, hereinafter Chislenko). The applicants respectfully traverse this rejection.

The Examiner's attention is requested to MPEP 2131, wherein it is stated:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Each of independent claims 1, 9, 14, 19, and 20, includes the limitation of computing a variance of the symbolic values of the plurality of items relative to the symbolic value of each of the items, and making a selection based on the symbolic value of an item that minimizes this variance.

Chislenko fails to teach computing a variance of the symbolic values of the plurality of items relative to the symbolic value of each of the items, and fails to teach making a selection based on the symbolic value of an item that minimizes this variance.

Additionally, the Board of Patents Appeals and Interferences has consistently upheld the principle that the burden of establishing a prima facie case resides with the Office, and to meet this burden, the Examiner must specifically identify where each of the claimed elements are found in the prior art: "there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). To meet [the] burden of establishing a prima facie case of anticipation, the examiner must explain how the rejected claims are anticipated by pointing out *where* all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

The Office action fails to identify where Chislenko teaches determining a variance, and fails to identify where Chislenko teaches making a selection based on this variance. The Office action asserts that Chislenko teaches computing a variance at column 10, lines 58-64. The cited text follows:

"After calculating the group centroids, determine to which group centroid each item is closest, and move it to that group. Whenever an item is moved in this manner, recalculate the centroids for the affected groups. Iterate until the distance between all group centroids and items assigned to each group are below a predetermined threshold or until a certain number of iterations have been accomplished." (Chislenko, column 10, lines 58-64.)

As can be seen, the cited text does not address determining a variance for each item, as asserted in the Office action.

In like manner, the Office action cites Chislenko's column 10, lines 32-64 for teaching selection based on variances determined for each item. However, at the cited text, Chislenko merely discloses clustering: "items are grouped in order to help predict ratings and increase recommendation certainty". The applicants note that clustering does not, per se, include determining variances for each item, and does not include a selection based on such variances.

Because Chislenko fails to teach computing a variance of the symbolic values of the plurality of items relative to the symbolic value of each of the items, and fails to teach making a selection based on the symbolic value of an item that minimizes this variance, and because the Office action fails to identify where Chislenko provides this teaching, the applicants respectfully maintain that the rejection of claims 1, 3-7, 9, 11-12, 14, 16-17, and 19-20 under 35 U.S.C. 102(b) over Chislenko is unfounded, per MPEP 2131.

The Office action rejects claims 8, 13, and 18 under 35 U.S.C. 103(a) over Chislenko and Keyes et al. (USP 7,003,484, hereinafter Keyes). The applicants respectfully traverse this rejection.

The Examiner's attention is requested to MPEP 2142, wherein it is stated:

"To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) *must teach or suggest all the claim limitations*... If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The rejected claims 8, 13, and 18 are dependent upon claims 1, 9, and 14, respectively. In this rejection, the Office action relies upon Chislenko for teaching the elements of claims 1, 9, and 14. As noted above, Chislenko fails to teach each of the limitations of claims 1, 9, and 14, and thus the applicants maintain that a rejection of claims 8, 13, and 18 under 35 U.S.C. 103(a) that relies upon Chislenko for this teaching is unfounded, per MPEP 2142.

In view of the foregoing, the applicants respectfully request that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Robert M. McDermott, Esq.
Registration Number 41,508
Phone: 804-493-0707
Fax: 215-243-7525

Please direct all correspondence to:

Yan Glickberg, Esq.
Philips Intellectual Property and Standards
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9618
Fax: (914) 332-0615